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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/221,099	12/28/1998	JAY S. WALKER	WD2-98-112	5153

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EXAMINER

ELISCA, PIERRE E

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/221,099

Applicant(s)  
Walker et al.

Examiner  
Pierre E. Elisca

Art Unit  
3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 16, 2002
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 17-26, 80, 86, and 87 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26, 80, 86, and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

***Response to Amendment***

1. This Office action is in response to Applicant's response, filed on 09/16/2002.
2. Claims 17-26, 80, 86, and 87 are pending.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 17-26, 80, 86 and 87 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Fraser (WO 97/08638) in view of West et al. (U.S. Pat. No. 5,845,259) and further in view of Jones (U.S. Pat. No. 5,832,458).

As per claims 17, 18, 20-22, 24-26, 80, 86 and 87 Fraser substantially discloses a point of sale terminal adapted to provide pricing information for selected products (which is equivalent to Applicant's claimed invention wherein said a method/system for promoting a sale of a substitute product, comprising:

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receiving transaction data regarding an original product presented for purchase by a consumer at a point of sale terminal (see., abstract, lines 2 and 3, wherein said a product to be purchased and generating a signal representing the code on the product to be purchased, page 4, page 8);

transmitting the transaction data to a remote server of a manufacturer during a transaction session for determination of a possible substitute product to be offered to the consumer (see., abstract, lines 3 and 4, wherein said this signal is then used to retrieve the price of the product from a first memory, it is also obvious to know that a server or computer is needed in order to process the code or the user's request, page 4, page 8);

upon receiving of information regarding a substitute product from the remote server, offering the substitute product to the consumer before the transaction session terminates (see., abstract, lines 4 and 5, wherein said the signal is also used to identify a product which is equivalent to the product to be purchased and to retrieve the price of the equivalent product, page 4, page 8, page 9 and 15); and consummating a sale of the original product if at least one of no information regarding the substitute product is received from the remote server, consumer declines the offering, and consummating a sale of the substitute product upon acceptance by the consumer (see., abstract, line 7, wherein said the price difference then be used by a consumer to decide if the equivalent product is a better value than the product he or she intended to purchase, page 4, page 9 and page 15). But he fails to specifically discloses the used of a remote server manufacturer and a remote retailer for transmitting transaction data. However, **West** discloses a point of sale including a terminal having a data reader transaction data, a remote retailer and manufacturer or remote server retailer manufacturer coupon redemption

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(see., col 2, lines 24-30, col 3, lines 31-37, col 4, lines 20-22). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add a retailer and a manufacturer remote server as taught by **West** into the point of sale terminal of **Fraser** because it would have been to eliminating the need for the manual collection of data transmission (see., West, col 3, lines 35-37). As specified by the Applicant's representative in the Amendment filed on 2/15/2002, page 3, that neither West nor Fraser disclose a manufacturer that is actively involved in retail transactions and sales efforts.

Jones discloses an audit system processor that is remotely located from the retail store for receiving the processed retail sales transaction data for subsequent use by MANUFACTURER see., abstract, col 1, lines 32, col 3, lines 6-28 (which is equivalent to Applicant's arguments detailed above. Accordingly, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of West and Fraser by including the limitation detailed above because such modification would provide the teachings of West and Fraser with the enhanced necessary to ensure the accurate and timely settlement between consumer goods manufacturers and the retailers of their products.

**As per claim 19, Fraser** discloses the claimed method wherein the transaction data includes at least one of: product price, product identifier and product UPC code (see., abstract, figs 1, 2, 4-6).

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**As per claim 23, Fraser** discloses the claimed method wherein the offering comprises transmitting information regarding the substitute product to the consumer via at least one of: a printer, a display terminal and a speaker (see., abstract, fig 4).

### **REMARKS**

5. In response to Applicant's argument, Applicant argues that the prior art of record taken alone or in combination do not teach or suggest: "determine a possible substitute product to be offered to a consumer during a transaction session". However, the Examiner respectfully disagrees because Fraser discloses in the abstract that a signal that is also used to identify a product which is equivalent to the product to be purchased, and therefore, it is the substitute product see., Fraser, abstract.

### ***Conclusion***

6. The prior art made of record and relied upon is considered to applicant's disclosure.

7. Any inquiry concerning this communication from the examiner should be directed to Pierre Eddy Elisca at (703) 305-3987. Starting on 10/22/2000 I will be in my office on **Monday, Tuesday, and Wednesday from 5:30AM. to 6:00PM.**

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768.

**Any response to this action should be mailed to:**

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Commissioner of patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry )

**OR:**


(703) 305-3718 ( for informal or draft communications, please label

“PROPOSED” or” DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA.,  
Sixth floor (receptionist ).

The Official Fax Number For TC-3600 is:

**(703) 305-7687**



**Pierre Eddy Elisca**

**Patent Examiner**

**January 14, 2003**